

PATENT
Attorney Docket No. UCSD-04871

REMARKS

Substitute Sequence Listing

The "Notice to comply with requirements for patent applications containing nucleotide and/or amino acid sequence disclosures" requested a substitute Sequence Listing in paper copy and computer readable form (CRF). Accordingly, enclosed is a paper copy (Tab 1) and a computer readable form of a substitute "Sequence Listing" which includes the sequence identifiers for Claim 7 as requested by the Examiner. The contents of the paper and computer readable copies are the same and include no new matter.

Applicants note that the Sequence Listing has been moved from its current location before the Claims to after the "Abstract," and numbered from pages 1-8.

Status of the Application

Claims 1, 2, 4, 5, 7-9, 11-13, 50-52, 54-56, and 59-88 are pending in the present application.

Claim cancellations and amendments in this communication were made to describe particular embodiment of the invention, notwithstanding Applicants' belief that the cancelled and unamended claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).¹

In particular, Claims 2, 12, 55-56, 60-63, 65-67, 69-73, and 83-88 have been cancelled. Claims 4, 5, and 77-82 have been amended to change their form into an independent claim. This is not a narrowing amendment because it changes the form, rather than the substance, of the claims.

Claim 7 has been amended to add sequence identifiers.

These amendments do not introduce new matter.

¹ 65 Fed. Reg. 54603 (September 8, 2000).

PATENT.
Attorney Docket No. UCSD-04871

Summary of Interview

In a telephone interview on 9/2/03 between Applicants' representative, Dr. Maha Hamdan, and Examiner Hines, the claims were discussed. At the interview, the Examiner explained that although Paper No. 13 did not include Claim 7 in the objection under 37 CFR §1.75(c),² this was a typographical error, and Claim 7 should have been objected to under 37 CFR §1.75(c).

Allowed Claims

Applicants note, with appreciation, that "Claims 1, 8, 9, 11, 13, 50-52, 54, 59, 64, 68,³ 74-76, 81-82 are allowed."⁴

Withdrawal of Rejections

Applicants note, with appreciation, withdrawal of the following rejections that were advanced in the prior office action:⁵

- (a) Rejection of Claims 6, 8-10 and 53-56 under 35 U.S.C. 112, second paragraph, for alleged indefiniteness;
- (b) Rejection of Claims 1-13 and 49-56 under 35 U.S.C. 112, first paragraph, as allegedly having inadequate written description; and
- (c) Rejection of Claims 1-13 and 49-56 under 35 U.S.C. 112, first paragraph, as allegedly non-enabled.

² Paper No. 13, page 3, item 4.

³ Applicants note that although Paper No. 13 says that Claims "64-68" are allowable, Applicants believe that this is a typographical error, and that the Examiner intended to allow Claims "64, 68" because the intervening Claims 65-67 were rejected for alleged inadequate written description on page 3, item 5, and Claim 67 was additionally rejected for alleged non-enablement on page 7, item 7 of Paper 13.

⁴ Paper No. 13, page 1, item 5; page 13, item 14.

⁵ Paper No. 13, page 2, item 2.

PATENT
Attorney Docket No. UCSD-04871

Claim Objections and Rejections

Claims 2, 4, 5, 7, 12, 63, and 77-80 were objected to, and Claims 2, 12, 55-56, 60-63, 65-67, 69-73, and 83-88 were rejected on the following grounds:

A. Objection to Claim 7:

Claim 7 was objected to for failing to comply with sequence requirements under 37 CFR §1.821(a)(1) and (a)(2).⁶ Sequence identifiers have been added.

B. Objection to Claims 2, 4, 5, 7, 12, 63, and 77-80 under 37**CFR 1.75(c)**

Claims 2, 4, 5, 7, 12, 63, and 77-80 were objected to under 37 CFR 1.75(c) on the basis that "claim 1 only encodes the amino acids 1 to 357 of SEQ ID NO:1" and that, therefore, the rejected claims fail "to further limit the subject matter of a previous claim."⁸ The Examiner suggested that Applicants "cancel the claim(s), or ... rewrite the claim(s) in independent form."

The Examiner has misconstrued the scope of Claim 1 which recites nucleic acid sequences "comprising" amino acids 1-357 of SEQ ID NO:1. Thus, contrary to the Examiner's erroneous construction, the express recitation of "comprising" in Claim 1 means that Claim 1 includes within its scope sequences which are additional to those encoding amino acids 1-357 of SEQ ID NO:1.

⁶ Paper No. 13, page 13, item 13.

⁷ Although Paper No. 13 did not include Claim 7 in the objection under 37 CFR §1.75(c), the Examiner explained in the telephonic interview that this was a typographical error, and Claim 7 should have been objected to under 37 CFR §1.75(c).

⁸ (Emphasis added) Paper No. 13, page 3, item 4.

PATENT
Attorney Docket No. UCSD-04871

Nonetheless, Claims 2, 12, and 63 have been cancelled, and Claims 4, 5, and 77-80 have been amended⁹ to rewrite them in independent form as suggested by the Examiner. Accordingly, this objection should be withdrawn.

**C. Rejection of Claims 55-56, 61-62, 65-67, 69-73 and 87-88
under 35 U.S.C. §112, first paragraph (written description)**

Claims 55-56, 61-62, 65-67, 69-73 and 87-88 were rejected under 35 U.S.C. §112, first paragraph, for alleged inadequate written description.¹⁰ Also, Claims 55, 56, 62, 67, and 87-88 were rejected under 35 U.S.C. §112, first paragraph, for alleged inadequate written description.¹¹ These rejections are moot in view of the cancellation of Claims 55-56, 61-62, 65-67, 69-73 and 87-88.¹²

⁹ Claim amendments were made to describe particular embodiment of the invention, notwithstanding Applicants' belief that the unamended claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).

¹⁰ Paper No. 13, page 3, item 5.

¹¹ Paper No. 13, page 6, item 6.

¹² Claim cancellations were made notwithstanding Applicants' belief that the cancelled claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).

PATENT
Attorney Docket No. UCSD-04871

D. Rejection of Claims 55, 56, 62, 67, and 87-88 under 35 U.S.C.

§112, first paragraph (enablement)

Claims 55, 56, 62, 67, and 87-88 were rejected under 35 U.S.C. §112, first paragraph, for alleged non-enablement.¹³ This rejection is moot in view of cancellation of Claims 55, 56, 62, 67, and 87-88.¹⁴

E. Rejection of Claims 2, 12, 60, 63, 70 and 83-88 under 35

U.S.C. §112, second paragraph

Claims 2, 12, 60, 63, 70 and 83-88 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness.¹⁵ This rejection is moot in view of cancellation of Claims 2, 12, 60, 63, 70 and 83-88.¹⁶

CONCLUSION

All grounds of rejection and objection of the final Office Action of June 11, 2003 having been addressed, reconsideration of the application is respectfully requested. Applicants

¹³ Paper No. 13, page 7, item 7.

¹⁴ Claim cancellations were made notwithstanding Applicants' belief that the cancelled claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).

¹⁵ Paper No. 13, page 11, item 8.

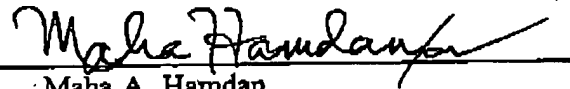
¹⁶ Claim cancellations were made notwithstanding Applicants' belief that the cancelled claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).

PATENT
Attorney Docket No. UCSD-04871

respectfully request the Examiner to call the undersigned before drafting another written communication, if any.

Signed on behalf of:

Dated: September 8, 2003



Maha A. Hamdan
Registration No. 43,655
MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(415) 904-6500